

Application No. 10/747,616
Response to Office Action mailed January 24, 2006
Atty. Dkt. No.: C261.1040.1

REMARKS

The foregoing amendment to the specification is provided to provide trademark information as requested by the Examiner, and to correct a few typographical errors. No new matter has been added. Claim 1 has been amended to delete reference to a few non-essential components of the invention, namely, NilsetTM 117, HapcoTM NXZ, DispersitolTM, and Borchio[®] Gol 112. Claims 5-7, previously withdrawn from consideration, have now been cancelled in order to facilitate allowance.

The Notice of Non-Compliant Amendment stated that the paragraphs to be amended were not adequately identified because the paragraphs in the specification as originally filed were not numbered. Applicants note that the guidance from the U.S. Patent and Trademark Office for how to amend paragraphs in the specification (<http://www.uspto.gov/web/offices/pac/dapp/opla/procognotice/formatrevamdtpac.pdf>) includes paragraph numbers, though it is not obvious from the guidance whether such numbers were present in the application as filed, or merely as published. The previously submitted paragraph numbers were found in the specification as published, and thus should have been adequately identified. Nevertheless, Applicants have replaced the paragraph numbers from the published application with the page and line numbers from the originally filed application. Should the Examiner have any difficulty identifying the correct paragraphs to amend, she is encouraged to contact Applicants representative.

Objections to the Specification

The specification was objected to on the basis that certain tradenames were not capitalized or accompanied by generic terminology. Where appropriate, the specification has been amended to reflect the TM or ® status of the marks.

Rejections under 35 U.S.C. 112, First Paragraph

Claims 1, 2, and 4 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, and as non-enabled. The basis for the rejection

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is that the claims recited various trademarks or tradenames without providing information on the chemical composition, function, etc., to identify the various compounds. The rejection is respectfully traversed if applied to the claims as amended.

Claim 1 has been amended to delete reference to NilsetTM 117, HapcoTM NXZ, DispersitolTM, and Borchio[®] Gel E2. Support for the revised claims is found in the specification at least in paragraph 27, where it states:

[0027] In a typical formulation 100-200 g typically 165 g of resin from a group consisting of alkyd, epoxy, or polyurethane, uralkyd and 100-200 g typically 166.2 g of TiO₂, 20-50 g, typically 28.5 g of Talc and Calcined clay, 0-30 g, as required in the formulation were added...

It is clear from paragraph 27 that the crux of the invention is the combination of the resin, TiO₂, talc and calcined clay, and the claim has been broadened appropriately. It is believed that this amendment overcomes the ground of rejection, and, accordingly, Applicants respectfully request that the rejection be withdrawn.

Rejections under 35 U.S.C. 112, Second Paragraph

Claims 1, 2, and 4 were rejected under 35 U.S.C. 112, second paragraph, as indefinite. The basis for the rejection is that the claims recited various trademarks or tradenames, which are purportedly not adequately described in the specification as originally filed. The amendment to Claim 1, as discussed above in connection with the rejections under 35 U.S.C. 112, first paragraph, is believed to also obviate this ground of rejection as well.

Rejections under 35 U.S.C. 103 (a)

Claims 1, 2, and 4 were rejected under 35 U.S.C. 103 (a), as obvious over U.S. Application Serial No. 2003/0195292 to Kuo et al. ("Kuo 1") or 2002/0183453 to Kuo et al. ("Kuo 2") in view of U.S. Patent No. 4,749,731 to Kyminas et al. ("Kyminas"). These rejections are respectfully traversed.

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The Claimed Subject Matter

The claims are directed to coating compositions that include alkyd resins, titanium dioxide, talc, calcined clay, and various other components.

Kyminas

Kyminas is directed to liquid coating compositions, which on air drying yield an elastic and adherent coating for protecting exterior wall and roof surfaces. The types of polymers in the Kyminas coatings are typically polyacrylic polymers, polyvinyl acetate polymers, polyvinyl chloride polymers, polyvinylidene chloride polymers, and combinations thereof, although Kyminas does suggest that any polymer would work if it provided suitable properties.

Kuo 1 and 2

Both Kuo 1 and Kuo 2 purportedly teach using alkyd-based resins as binders in pigmented coating compositions in order to form durable coatings.

Analysis

The basis for the rejection is that it would purportedly be obvious to use the alkyd-resin of Kuo in the coating compositions of Kyminas. Applicants respectfully assert that there is no suggestion in the references to support this combination. Different coatings require different polymers, with different properties, and there is no motivation to substitute the thermoset alkyd resins of Kuo for the thermoplastic polymers in Kyminas.

Each of the polymers in Kyminas is a thermoplastic polymer. Thermoplastic polymers are more elastic, by definition, than thermoset polymers (like alkyd resins). Particularly where, as in Kyminas, flexibility and elasticity are critical features of the polymers, particularly for their use in roofing and external wall applications, there would be no motivation to substitute a thermoset alkyd resin, which would not have these properties. Support for this principle can be found, for example, at <http://www.vilresins.com/data.htm> (copy attached), which shows that, of several resins, only thermoplastic acrylic resins are suitable for use in roofing applications (and alkyds are listed for different uses).

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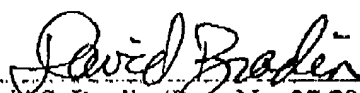
Because there would be no motivation in the art to combine the references as suggested in the Office Action, Applicants respectfully request that the rejections be withdrawn.

Conclusion

On the basis of the above-presented arguments and amendments, it is believed that the application is now in condition for allowance. Prompt consideration and allowance is respectfully requested. The Office is invited to contact the undersigned at (919) 484-2382 regarding any question concerning this filing.

Respectfully submitted,

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